



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,552	02/13/2002	Ryuji Biro	1232-4819	8407
27123	7590	08/20/2008		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
LU, JIPING				
ART UNIT		PAPER NUMBER		
3749				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

# Office Action Summary

**Application No.**

10/075,552

**Applicant(s)**

BIO ET AL.

**Examiner**

Jiping Lu

**Art Unit**

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claims Status***

1. Claims 1-33 have been canceled. Claims 34-37 and new 38 are pending. The newly added product by process claim 38 may subject to restriction requirement at a later time based on constructive election of claims 34-36. Currently, the product by process claim 38 is readable on any "optical lens" under 35 USC 102.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/17/08 has been entered.

### ***Claim Rejections - 35 USC § 102***

3. Claims 34-36 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tomoharu et al. (JP 11-224839).

Tomoharu et al. discloses a rinsing method comprising the steps of accommodating an article 2a-2d, 4a-4b, to be rinsed, into a second container 2g which is disposed inside a first container (room used to house the container 2g), introducing an oxygen gas 10a into the second container 2g, irradiating the article with ultraviolet rays from a light source 1 disposed outside

second container, wherein the internal pressure in the second container is higher than the first container, (the second container is pressurized during operation) and introducing a nitrogen gas 8a into the second container 2g and exhausting/discharging (thru 9a) the oxygen gas in the second container 15 to exchange an ambience of the second container same as claimed. The oxygen gas or the ozone gas in the first container is substantially exhausted (thru doors or windows of aforementioned room used to house the second container 2g). During the operation, there will be some N<sub>2</sub> in the ambience. It should be noted that N<sub>2</sub> does exist in ambience or atmosphere. . The article is unloaded from the first and second containers after leaving the article in the nitrogen containing ambience. It is inherent that the article will be unloaded from the first and second containers after rinsing. The second container has a clearance (from the statement of page 3, lines 44-46, it is implicitly disclosed that there is a clearance, otherwise it would mean that the container 15 is perfectly sealed and there would not be a need for maintaining a higher pressure inside) through the first container. The first gas supplying means 8a,10a is configured to introduce the rinsing gas into the second container to maintain an ambience in the second container (see page 3, lines 16-17) which ambience is different from that of said first container and also to keep an internal pressure higher than that of said first container (see page 3, lines 44-46). For product by process claim 38, see optical lens 2, 4.

***Claim Rejections - 35 USC § 102/103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Mukai (U.S. Pat. 5,120,394).

Mukai shows in Fig. 1 an exposure apparatus 2 including an optical lens 11 same as claimed. Mukai discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase "having been rinsed in accordance with the rinsing method as recited in claim 34" is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, it appears that the product in Mukai would be the same or similar as that claimed.

6. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamiya (U.S. Pat. 4,989,031).

Kamiya shows in Fig. 1 an exposure apparatus 20 including an optical lens 4 same as claimed. Kamiya discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase "an optical lens having been rinsed in accordance with the rinsing method as recited in claim 34" is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an

unobvious difference. See MPEP 2113. Thus, it appears that the product in Kamiya would be the same or similar as that claimed.

7. Claim 38 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tomoharu et al. (JP 11-224839).

Tomoharu et al. shows in Fig. 1 an exposure apparatus 2g including an optical lens 2a-2d, 4a-4b same as claimed. Tomoharu et al. discloses each and every structural element of an exposure apparatus set forth in claim 38. The claimed phrase “an optical lens having been rinsed in accordance with the rinsing method as recited in claim 34” is being treated as a product by process limitation; that is, the optical lens is rinsed by the method recited in claim 34. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C.102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113. Thus, it appears that the product in Tomoharu et al. would be the same or similar as that claimed.

#### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomoharu et al. (JP 11-224839).

The rinsing method of Tomoharu et al. as above includes all that is recited in claim 37 except for the material of the article to be cleaned. With regard to the claimed material of the

article to be cleaned, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the article with any kind of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

10. Claims 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamiya (U.S. Pat. 4,989,031) in view of Mukai (U.S. Pat. 5,120,394) and Kuzumoto et al. (U. S. Pat. 6,616,773).

Kamiya shows a rinsing method comprising providing a first container I, a light emitting unit 1, 11, 12 disposed inside the first container I for emitting laser lights, a second container II, III disposed inside the first container I and being adapted to accommodate an article 2, 4 to be rinsed, the second container II, III having a clearance through the first container I (see Fig. 1), a first gas supplying means 31, 32 for introducing a rinsing gas into the second container II, III to maintain an ambience of the second container which ambience is different from that of the first container and also to keep an internal pressure higher than that of the first container I (col. 4, lines 18-25). The internal pressure in the second container II, III is higher than the first container I, (the second container is pressurized during operation). The oxygen gas is exhausted in the first container I so that a nitrogen containing ambience remains in each of the first and second containers (see Col. 6, lines 7-30). During the operation, there will be some N<sub>2</sub> in the ambience. It should be noted that N<sub>2</sub> does exist in ambience or atmosphere. However, Kamiya does not show irradiating the article with ultraviolet rays and introducing a nitrogen gas into the second container and exhausting the oxygen gas or ozone gas in the second container to

exchange an ambience of the second container. Mukai teaches a concept of using ultraviolet light generator for irradiating a laser ray (wavelength: 193 nm) over the surface of substrate 11 (col. 5, lines 6-9) and introducing N<sub>2</sub> gas 8, 9 into the inner (second) container. Kuzumoto et al. teach a concept of introducing a nitrogen gas into the second container 1 and exhausting the oxygen gas or ozone gas in the second container to exchange an ambience of the second container (col. 2, lines 33-36 and Fig. 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify method of Kamiya to include a step of supplying ultraviolet rays as taught by Mukai and a step of introducing a nitrogen gas to the second container for replacing the oxygen gas or ozone gas in the second as taught by Kuzumoto et al. in order to more efficiently clean the articles inside the second container. With regard to the claimed material of the article to be cleaned, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the article with any kind of material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

#### ***Response to Arguments***

11. Applicant's arguments filed on 7/18/08 have been carefully considered. However, the arguments are not persuasive to overcome the rejection. Claims presented still fail to define over the prior art references. With regard to the 35 USC 103 rejections, since each and every claimed process step is shown by the prior art references, therefore, it would have been obvious to one skilled in the art to modify method of Kamiya to include a step of supplying ultraviolet rays as



taught by Mukai and a step of introducing a nitrogen gas to the second container for replacing the oxygen gas or ozone gas in the second as taught by Kuzumoto et al. in order to more efficiently clean the articles inside the second container. In view of the combined teaching of the prior art references, one skilled in the art would have found it to be obvious to combine because the results would have been predictable (see KSR International Co. v. Teleflex, Inc. 82 USPQ 2d 1385 (2007)).

### *Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jiping Lu whose telephone number is 571 272 4878. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, STEVEN B. MCALLISTER can be reached on 571 272-6785. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/075,552  
Art Unit: 3749

Page 9

/Jiping Lu/  
Primary Examiner  
Art Unit 3749

J. L.